UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,805	05/31/2000	Peter M. Redling	K41-002 US	2289

7590 12/29/2004

Notaro & Michalos PC
Suite 110
100 Dutch Hill Road
Orangeburg, NY 10962-2100

EXAMINER	
NALEVANKO, CHRISTOPHER R	
ART UNIT	PAPER NUMBER
2611	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/584,805	REDLING ET AL.	
	Examiner	Art Unit	
	Christopher R Nalevanko	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 August 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 1-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding Claims 1 and 12, the claimed limitation "the icon and associated advertising information being un-associated with the television program" recited in Claim 1 (lines 10-11) and Claim 12 (lines 12-14, 17-21) is not supported by the specification. Additionally, Applicant points to the paragraph bridging pages 10 and 11 for support but the Examiner fails to find the claimed limitation. Specifically, the stated paragraph does not state anything about icons "un-associated" with the television programming. Furthermore, there is nothing that describes the television programming content so that the Examiner could decide what content would be "un-associated." All of the other claims are dependent upon either claim 1 or claim 12.

Response to Arguments

2. Applicant's arguments with respect to claims 1 and 12 have been considered but are moot in view of the new ground(s) of rejection.

3. Regarding Claims 5, 10, and 13, Applicant's failure to adequately traverse the Examiner's taking of Official Notice in the last office action is taken as an admission of the facts noticed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kitsukawa et al in further view of Shoff et al and Schein et al (2003/0208758).

Regarding Claim 1, Kitsukawa shows a method of providing advertising to a subscriber through a set top communications box connected to a television (col. 2 lines 18-61, fig. 2 item 39), the method comprising transmitting icons and associated advertising information to the set top communications box (col. 6 lines 40-64), displaying an icon on the television screen over a television program (col. 7 lines 10-20, col. 8 lines 18-36), detecting an input signal indicating the icon has been selected with the set top box (col. 7 lines 20-40), retrieving the advertising information associated with the icon, and displaying the advertising information on the screen (col. 7 lines 20-40). Although Kitsukawa suggests that this system could be connected to a computer network (col. 4 lines 55-67), he fails to specifically state that this is a global computer network and that icons and advertising information are stored on a server connected to the global computer network. Shoff shows a set-top communications box connected to a global computer

network. This global communications network stores advertising information and related information on a server (page 2 sections 0015, 0029, page 3 sections 0031, 0035, page 4 sections 0047-0048). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kitsukawa with the ability to connect to a global computer network so that the system would have access to a wide variety of data that could be displayed on the user's screen.

Both Kitsukawa and Shoff fail to specifically state that the icon and advertising information are un-associated with the television program. Schein shows that the icon and advertising information can be un-associated with the television program (page 9 sections 0074-0075). Schein shows that a user can be displayed advertising information for Budweiser merchandise while watching a sports event. The advertising is therefore un-associated with the program, which is a sporting program. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kitsukawa and Shoff with the ability to display advertising information regarding un-associated items so that the user could be provided with a greater variety of advertisements and also advertisements based on other determinative factors.

Regarding Claim 2, Kitsukawa shows that the advertising information is displayed in a distinct frame on the screen (col. 7 lines 20-40).

Regarding Claim 3, Kitsukawa shows superimposing an icon over a television program (col. 7 lines 10-21, col. 8 lines 15-50).

Regarding Claim 4, Kitsukawa shows that if a user does not input a response to one icon, a second icon for another item is shown after a period of inactivity (col. 7 lines 40-60).

Regarding Claim 5, Kitsukawa, Shoff, and Schein fail to specifically state the length of time that elapse between the display of a first icon and the display of a second icon. Official Notice is given that it is well known and expected in the art to use a variety of time lengths between displaying successive items. This allows enough time for the user to select the icon, but not too much time in the event the user is not interested in the current icon and is waiting for the next. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kitsukawa, Shoff, and Schein with the 1 to 5 minute duration so that a user would be provided with new icons in a timely manner in the event the user is not interested in the present icon.

Regarding Claim 6, Kitsukawa shows transmitting advertising information to the memory of the set-top box for display on the user's screen and following detecting on of the icons has been selected, transmitting the advertising information to the set-top box (col. 6 lines 6-17, 40-65, col. 7 lines 10-52).

Regarding Claim 7, Shoff shows a variety of display methods, including displaying advertising data in the main portion of the screen in place of television program data (page 6 sections 0068, 0069, 0076, page 7 sections 0077, 0078, fig. 8c).

Regarding Claim 8, Kitsukawa shows transmitting advertising information to the memory of the set-top box for display on the user's screen and following detecting one of

the icons has been selected, transmitting the advertising information to the set-top box (col. 6 lines 6-17, 40-65, col. 7 lines 10-52).

Regarding Claim 9, Kitsukawa shows that if a user does not input a response to one icon, a second icon for another item is shown after a period of inactivity (col. 7 lines 40-60).

Regarding Claim 10, Kitsukawa, Shoff, and Schein fail to specifically state the length of time that elapse between the display of a first icon and the display of a second icon. Official Notice is given that it is well known and expected in the art to use a variety of time lengths between displaying successive items. This allows enough time for the user to select the icon, but not too much time in the event the user is not interested in the current icon and is waiting for the next. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kitsukawa, Shoff, and Schein with the 1 to 5 minute duration so that a user would be provided with new icons in a timely manner in the event the user is not interested in the present icon.

Regarding Claim 11, Kitsukawa shows superimposing an icon over a television program (col. 7 lines 10-21, col. 8 lines 15-50).

Regarding Claim 12, Kitsukawa shows a method of providing advertising to distributed lcoations (col. 2 lines 18-61, fig. 2 item 39), the method comprising transmitting icons and associated advertising information to the set top communications box (col. 6 lines 40-64), displaying an icon on the television screen over a television program (col. 7 lines 10-20, col. 8 lines 18-36), detecting an input signal indicating the

icon has been selected with the set top box (col. 7 lines 20-40), retrieving the advertising information associated with the icon, and displaying the advertising information on the screen (col. 7 lines 20-40). Kitsukawa shows that if a user does not input a response to one icon, a second icon for another item is shown after a period of inactivity (col. 7 lines 40-60). Although Kitsukawa suggests that this system could be connected to a computer network (col. 4 lines 55-67), he fails to specifically state that this is a global computer network and that icons and advertising information are stored on a server connected to the global computer network. Shoff shows a set-top communications box connected to a global computer network. This global communications network stores advertising information and related information on a server (page 2 sections 0015, 0029, page 3 sections 0031, 0035, page 4 sections 0047-0048). This server head-end provides the set-top communications box with advertising information and supplemental information. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kitsukawa with the ability to connect to a global computer network so that the system would have access to a wide variety of data that could be displayed on the user's screen.

Both Kitsukawa and Shoff fail to specifically state that the icon and advertising information are un-associated with the television program. Schein shows that the icon and advertising information can be un-associated with the television program (page 9 sections 0074-0075). Schein shows that a user can be displayed advertising information for Budweiser merchandise while watching a sports event. The advertising is therefore un-associated with the program, which is a sporting program. It would have been

obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kitsukawa and Shoff with the ability to display advertising information regarding un-associated items so that the user could be provided with a greater variety of advertisements and also advertisements based on other determinative factors.

Regarding Claim 13, Kitsukawa, Shoff, and Schein fail to specifically state that the communications box has a distinct address. Official Notice is given that it is well known and expected in the art to provide electronic equipment in a network a distinct address, such as an IP address. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kitsukawa, Shoff, and Schein with a unique address of the communications box in order for the head-end system to recognize a user site.

Regarding Claim 14, Kitsukawa shows transmitting advertising information to the memory of the set-top box for display on the user's screen and following detecting on of the icons has been selected, transmitting the advertising information to the set-top box (col. 6 lines 6-17, 40-65, col. 7 lines 10-52).

Regarding Claim 15, Kitsukawa shows superimposing an icon over a television program (col. 7 lines 10-21, col. 8 lines 15-50).

Regarding Claim 16, Kitsukawa shows transmitting advertising information to the memory of the set-top box for display on the user's screen and following detecting on of the icons has been selected, transmitting the advertising information to the set-top box (col. 6 lines 6-17, 40-65, col. 7 lines 10-52).

Regarding Claim 17, Kitsukawa shows superimposing an icon over a television program (col. 7 lines 10-21, col. 8 lines 15-50).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R Nalevanko whose telephone number is 703-305-8093. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on 703-305-4755. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher Nalevanko
AU 2611
703-305-8093

cn

CHRIS GRANT
PRIMARY EXAMINER